

Serial No. 10/729,201
Atty. Doc. No. 2002P06120WOUS

MAR 05 2007

REMARKS

Claims 1-9 and 11-22 are pending in the application. The Examiner has indicated that the Applicant's claim for priority under 35 USC 119 cannot be based on two German applications that were filed more than twelve months prior to the filing date of the present application. Claims 1-9 and 11-22 are rejected under 35 USC 112, first paragraph as a result of the use of the term "width corresponding to the surface to be melted". Claims 1, 12 and 13 are objected to due to a lack of antecedent basis for the limitation "the focus length". Claims 1-4, 11, 14 and 22 are rejected under 35 USC 103(a) as being unpatentable over Kurz in view of Foster. Claim 7 is rejected under 35 USC 103(a) as being unpatentable over Kurz and Foster in view of Marcin. Claims 5, 6, 9, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claim of Priority:

The Examiner's comments regarding the claim of priority appear directed to the format of the Declaration, which the Examiner is interpreting as being a claim of priority only to the two parent German applications and not a claim of priority to the International PCT application which in turn claims benefit of the two German applications. It is noted that there is disagreement among various Art Units of the USPTO as to the proper citation of the parent PCT application in the Declaration, and that the format used in the present Declaration has been found to be acceptable by other Art Units for other applications. Nonetheless, the applicant has also claimed priority to the International Application, and thereby to the filing date of the two German applications, via the CROSS REFERENCE TO RELATED APPLICATIONS that was inserted into the specification via the Preliminary Amendment. Since a claim of priority in this manner satisfies all of the requirements of the Regulations, the present application should receive benefit of the filing date of the two German applications.

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Claim Rejections under 35 USC 112:

The Applicant notes that Figure 3 and the description of the specification do, in fact, support the claim language of "a width corresponding to the surface to be melted" because the word "corresponding" should not be interpreted as meaning "equal to". As illustrated in the figures and described in the specification, the width of the present invention is made greater than its length in order to correspond to a width of the surface to be melted so that only a single pass of the energy beam may be necessary where in the prior art multiple passes may have been required.

Notwithstanding the above, the rejected language has been eliminated herein and the rejection under 35 USC 112 has been overcome.

Since there are no prior art rejections or objections to independent claim 15, that claim and its dependent claims are thereby now in condition for allowance.

Claim Objections:

Claims 1, 12 and 13 have been amended herein to overcome the objections to these claims.

Claim Rejections under 35 USC 103(a):

Independent claim 1 includes the limitations of "melting a surface of the monocrystalline layer by an energy input of an energy source by a focal spot of the energy source having a geometry with a width sufficiently wide to melt a desired width of the surface to be melted and a length in a direction of movement of the focal spot transverse to the width that is less than the width." In contrast, Kurz describes a round laser spot of only 2.5 mm at column 4, line 64, which actually teaches away from the claim 1 limitations. It may be said that the round laser spot of Kurz is directed to the surface at an angle which may cause it to be somewhat elongated (elliptical) in its projection upon the surface. However, any possible elongation of the round spot of Kurz as projected on the surface would have a length in a direction of movement of the focal spot that is more than the projected width, as illustrated in Figure 4 of Kurz, thereby again

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teaching away from the limitations of claim 1. The addition of Foster to Kurz fails to rectify this fundamental deficiency in the prior art.

The Examiner admits that "the combination of Kurz et al and Foster et al teaches a round shape." The Examiner then finds that changes in shape are obvious under MPEP 2144.04. However, MPEP 2144.04 does not support this rejection because MPEP subsection 2144.04(IV)A makes it clear that a change in relative dimensions is not patentable only if "a device having the claimed relative dimensions would not perform differently than the prior art device." In the present invention, the use of a focal spot with a width longer than its length in a direction of movement of the spot provides a powerful advantage by eliminating overlap between successive passes, thereby eliminating a major source of the geometrical conditions that lead to non-epitaxial growth (page 2 line 33 through page 3, line 5 of the present specification). Thus, the findings of *Gardner v. TEC Systems, Inc.* that are cited in MPEP 2144.04(IV)A are not applicable to the present invention. Furthermore, subsection 2144.04(IV)B makes it clear that a change in the configuration of a device is not patentable absent evidence that the particular claimed configuration is significant. In this case, there is ample evidence that the claimed greater width is very significant, as described in detail in the present specification. Therefore, the findings of *In re Dailey* that are cited in MPEP 2144.04(IV)B are not applicable to the present invention.

Accordingly, when the cited prior art teaches away from a claimed method step, and there is particular significance to the claimed method step for achieving results superior to the prior art, a finding that it was obviousness to modify the prior art, without any teaching or suggestion of such modification being present in the prior art, is without merit. Therefore, the rejection of independent claim 1 and its dependent claims under 35 USC 103 should be withdrawn.

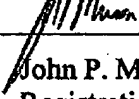
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Conclusion:

The Commissioner is hereby authorized to charge any appropriate fees due in connection with this paper or credit any overpayments to Deposit Account No. 19-2179

Respectfully submitted,

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